WEB COPY

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 28.02.2024

CORAM

MR.JUSTICE N.SESHASAYEE

(T)CMA(TM)/165/2023
(OA/SR.57/2019/TM/CHN)

Aditya Birla Fashion and Retail Limited
Madura Fashion & Lifestyle "Khata No.118/110/1
Building 2, Divyashree Technopolis, Yemalur Post
Off HAL Airport Road, Bengaluru 560 037
Karnataka Bangalore 560037, Karnataka ... Appellant

Vs.

1.The Deputy Registrar of Trade Marks
Trade Marks Registry
Intellectual Property Building
G.S.T. Road, Guindy
Chennai 600 032

2.Lal Singh Verma
trading as M/s.RS Sales Corporation
a Proprietor Concern
10-11, Prakashwanti Palace
Hing Ki Mandi, Agra, U.P. ... Respondents

https://www.mhc.tn.gov.in/judis

WEB COPY

PRAYER: Transfer Civil Miscellaneous Appeal (Trade Marks) filed under Section 91 of the Trade Marks Act, 1999, praying to set aside the order dated 14th March 2019, in opposition No.875693 to Application No.2007198, abandoning the Trademark Application and direct the 1st respondent to restore the application on file and allow the applicant to further prosecute the respondent as per law.

For Appellant : M/s.C.P.Chithra

For Respondents : Mr.S.Janarthanam
SPC - R1

No Appearance - R2

JUDGMENT

This appeal is filed challenging the order of the 1st respondent dated 14.03.2019 by which the 1st respondent had held that the application of the appellant to register its mark is deemed to have been abandoned within the meaning of Rule 46(2) of the Trade Marks Act, 1999.

2. The appellant has applied for registering its mark 'PETER ENGLAND' beneath which is written in Italics '*British Micros*', in Class 25. The

https://www.mhc.tn.gov.in/judis

WEB COPY

appellant had registered innumerable marks in different combinations with 'PETER ENGLAND' as the most prominent word. The other facts relevant for the current purpose are as below:

a) A search was made and a publication in the Trade Mark Journal too was made and it invited opposition from the 2nd respondent herein. The counter of the opposition indeed was circulated to the appellant and the appellant had responded to the same with its reply statement.

b) While so, on 18.07.2017, the 1st respondent forwarded the copy of the counter statement filed by the appellant to the 2nd respondent and required the 2nd respondent to file its evidence within two months. The 2nd respondent had filed its evidence and it was on 04.09.2017 the copies thereof were received by the appellant.

c) The appellant on its part sought extension of time at least twice. As per the last extension sought, the appellant had undertaken to file his evidence 06.01.2018. While so, on 05.01.2018, the appellant has e-mailed the 1st respondent that it relies on its counter and also the documents filed along with the counter, and stated to have informed the first respondent that it did not propose to file any additional

https://www.mhc.tn.gov.in/judis

WEB COPY

evidence.

It is in these circumstances, the Trade Marks Registry has passed an order on 14.03.2019 that the 1st respondent has held that, inasmuch as the appellant has not filed its evidence but has only chosen to intimate the Trademark Registry of its intent to rely on its counter in TM-M Form, and since no separate intimation was filed, the appellant was deemed to have abandoned its application. This Order of the first respondent is now under challenge.

3. Heard both sides. The approach of the Trade Marks Registry is shocking to state the least. Is the Trade Marks Registry plainly insensitive? Here is a scenario where the appellant has done everything that is required to be done. It is not even denied or disputed by the 1st respondent that the appellant had communicated its intent to rely on its counter and accompanying documents in TM-M Form, but that no separate information was given as per the procedure contemplated. This Court would have appreciated if the Trade Marks Registry had been less fastidious in such procedural aspects of its functioning and focused on the vitals aspects critical for deciding the issue.

https://www.mhc.tn.gov.in/judis

WEB COPY

The 1st respondent, as statutory authority is expected to do a statutory job and is not expected to discipline the litigant like a High School Head Master. And, if it is keen that a separate information is required to be filed in any specific forms, then it could have informed the appellant or its agent about it. Will heaven fall if the 1st respondent had informed the appellant of the former's insistence on its requirements? This Court plainly cannot appreciate the hyper reactive approach of the 1st respondent to what this court considers as a trivia. With greater maturity and sensitivity on his part, this litigation could have been avoided.

4. To conclude, this appeal stands allowed. The matter is remanded back to the Trade Marks Registry and it is now required to attend to the substance of what is expected to be done by it under the Act with the seriousness that it is engaged in a statutory function of substantial kind which impact the commercial interest of the parties. There is no order as to the costs.

28.02.2024

kas

https://www.mhc.tn.gov.in/judis

WEB COPY

Index : Yes / No
Neutral Citation: Yes / No

N.SESHASAYEE, J.

kas

(T)CMA(TM)/165/2023
(OA/SR.57/2019/TM/CHN)

28.02.2024

https://www.mhc.tn.gov.in/judis